

DETAILED ACTION

This office action is in response to claims 35-38 missing in the previous office action (rejected under 102 in view of DWYER below). Currently amended claims 29-42 are pending and rejected below.

Response to Arguments

Applicant's arguments filed 1/7/2008 have been fully considered but they are not persuasive.

Applicant argues that the claim limitations of "a deployer within the pod and attachable to the medical device" is not disclosed in the prior art of record, namely Dwyer.

Claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969).

Under these guidelines, it is examiners position that the Dwyer does disclose a the deployer within the pod and attachable to the medical device. Examiner draws applicant's attention to figures 10A, 10B and 10C in Dwyer and the deployer, which is unnumbered in these figures (deployer 28 i.e.). It is examiners position that the deployer is "within" the pod. Examiner is reading the term "within" to mean

- a. In the scope or sphere of
- b. Inside a specified amount or degree

Examiner is not reading the term to mean "completely enclosed" or "covered".

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner is given a broad reading of "within" and Dwyer discloses this interpretation. Further examiner is of the position that the pod is "attachable" to the medical device. A recitation with respect to the manner in which a claimed apparatus is intended to be employed ("attachable" to a medical device) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation.

Again, it is recommended that applicant amend the claims to greater define the exact movement of the deployer and its movement in relation to other elemental structures, if that is where they feel there novelty lies.

In summation the elements disclosed in Dwyer are fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended claims, as currently written, and the rejection is made and proper. See maintained rejections discussed below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 29-30, 32-33, 35-38 rejected under 35 U.S.C. 102(e) as being anticipated by Dwyer et al. (U.S. Patent Number 6,395,017). Dwyer discloses a catheter device (Figure 3-5) for the deployment of a medical device, with an polymeric elongate tubular body (elements 34 to elements 32 of figure 3 specifically 22 and 18), with an embracing pod (23) located at the distal end (30 as one example) of the catheter tubular body for reception of the medical device and with sufficient axial rigidity, a deployer (28 or 4) movable through the pod. Further Dwyer comprises a funnel shaped bored loading device (figure 6 element 44), with a thin walled loading tube (4) projecting from a main support (44). It is examiners position that the thin walled distal portion of the catheter tubular body is of reduced wall thickness relative to a proximal portion of the catheter tubular body (elements from 20 thick section to thin or reduced section 22) and the pod has a greater flexibility then the proximal portion of the tubular body (20). All the elements of Dwyer are fully capable of satisfying all structural, spatial, functional, and operational limitations of the claims as written.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 31, 34, 39-40, and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dwyer.

In regards to claim 31, Dwyer discloses the claimed invention except for the tubular body tapers distally at a location proximal and adjacent the pod. It would have been an obvious matter of design choice to for the tubular body tapers distally at a location proximal and adjacent the pod, since it is well known in the catheter arts for wall thickness and structure to taper to enhance flexibility, support, and define a lumen.

In regards to claim 34, Dwyer discloses the claimed invention except for a wall thickness of less than or equal to 0.004 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wall thickness of less than or equal to 0.004 inches, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In regards to claims 39-40, Dwyer discloses the claimed invention except is silent as to the cone angles of the bore between 15 and 65 degrees or 35 and 45 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct a cone with angles of the bore between 15 and 65 degrees or 35 and 45 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955).

In regards to claim 41-42, Dwyer discloses the claimed invention except is silent as to the main support being made from Perspex or a metal spigot, and the loading tube from polytetrafluoroethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the main support from Perspex or a metal spigot, and the loading tube made from polytetrafluoroethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571)272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767